

### **Remarks/Arguments**

The specification has been amended to correct errors noted therein. No new matter has been added by any of the amendments to the specification.

The Examiner has objected to the Abstract because it exceeds 150 words. By the present Amendment, the Abstract has been amended to comprise less than 150 words. The Abstract is now believed to fully comply with the requirements of the Patent and Trademark Office, and withdrawal of the objection to the Abstract is respectfully requested.

The Examiner has objected to the drawings because reference number **332** in **Figure 3** is not mentioned in the specification. A corrected drawing sheet in which element **332** has been deleted from **Figure 3** is attached hereto. An annotated drawing sheet showing the changes is also attached hereto.

Claims 1, 3-13, 15, 17, 19-29, 31 and 33-42 remain pending in the present application. Claims 1, 8, 9, 13, 15, 17, 24, 25, 29, 31, 41 and 42 have been amended, and claims 2, 14, 16, 18, 30, 32 and 43 have been canceled. No claims have been added. Applicants have carefully considered the cited art and the Examiner's comments, and believe the claims currently in the case patentably distinguish over the cited art and are allowable in their present form. Reconsideration of the rejections is, accordingly, respectfully requested in view of the above amendments and the following comments.

#### **I. 35 U.S.C. § 101**

The Examiner has rejected original claims 31-43 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

In rejecting original claims 31-43, the Examiner asserts that Applicants are claiming program information stored on a recordable medium, and appears to take the position that such claims are directed to non-statutory subject matter. In support of his position, the Examiner reproduces portions of Chapter 2200 of the MPEP that describe various categories of non-statutory subject matter. The Examiner does not, however, indicate how the reproduced portions are pertinent to original claims 31-43 of the present application.

The portions of Chapter 2200 of the MPEP reproduced by the Examiner, in fact, are not pertinent to claims 31 and 33-42 as presented herein. For example, claims 31 and 33-42 are not directed to abstract ideas or to nonfunctional descriptive material. The claims are also not directed to solving a mathematical problem, nor do the claims consist of mathematical operations.

To the contrary, claims 31 and 33-42 are directed to a computer program product in a computer readable medium, and claims in such form fully comply with the requirements of 35 U.S.C. § 101 as is confirmed by the MPEP.

For example, in the first paragraph in the first column on page 2100-13 of the MPEP, it is stated that data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in a computer. However, it is further stated:

In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Further, in the first full paragraph in the second column on page 2100-13 of the MPEP, it is stated:

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office Personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory (emphasis added).

Claims 31 and 33-42 do recite a computer program in conjunction with a computer readable medium needed to realize the computer program's functionality. Claims 31 and 33-42 are, therefore, directed to statutory subject matter and fully satisfy the requirements of 35 U.S.C. § 101. Withdrawal of the rejection of claims 31 and 33-42 as being directed to non-statutory subject matter is, accordingly, respectfully requested.

Therefore, the rejection of claims 31 and 33-42 as being directed to non-statutory subject matter has been overcome.

## II. 35 U.S.C. § 102, Anticipation

The Examiner has rejected original claims 1-43 under 35 U.S.C. § 102(e) as being anticipated by Barni et al, (U.S. Patent No. 6,064,981). This rejection is respectfully traversed.

Barni et al. (hereinafter Barni) is directed to a technique by which users of online systems may negotiate cargo rates with one another in an anonymous manner, and in which freight forwarders and carriers may post published rate and discount information.

In Barni, a server in a computer network operates a web site at which a plurality of freight forwarders/carriers may publish rates in a centralized location. Customers may browse the site to obtain rate data, and may also negotiate with a seller using the site to secure a cargo shipping commitment. For example, a customer may post a bid at which it is willing to purchase an item, or a seller may post a bid at which it is willing to sell an item.

In rejecting the claims, the Examiner states the following:

Barni et al. teach all the limitations of Claims 1-16. For example, Barni et al. disclose a method for identifying an item for purchase to a buyer, using the online service to identify competitive prices (e.g. one or more competing businesses) for an item (e.g. a unit of cargo space), and sellers competing for the customer's business by openly viewing competing offers (see at least abstract: col. 1, line 7 through col. 2, line 38). Barni et al. further disclose:

- Receiving a selection of an item for sale: users selecting items from a web site; central system receiving a selection of a selected item (unit of cargo space) for sale by an entity desiring to purchase the item (see at least col. 1, lines 8-61; col. 5, lines 15-30).
- Generating a priced object: first electronic system provides sale item(s) (see at least col. 5, lines 15-30); document or other object formatted according to HTML (see at least col. 1, lines 36-41).
- Providing the priced object: central system provides priced object to a second system (see at least Fig. 2 (32); Fig. 4 (66); col. 4, lines 15-41).

Office Action dated February 26, 2004, pages 5 and 6.

Claim 1 of the present application, as amended herein reads as follows:

1. A computer-implemented method for purchasing an item for sale, comprising:
  - receiving a selection of the item for sale in a first electronic business;
  - generating a priced object for the selected item, the priced object describing terms of an offer of sale of the selected item by the first electronic business; and
  - receiving the priced object by a second electronic business, wherein the second electronic business modifies the priced object.

Barni does not disclose the step of generating a priced object for the selected item, the priced object describing terms of an offer of sale of the selected item by the first electronic business; or the step of receiving the priced object by a second electronic business, wherein the second electronic business modifies the priced object. Instead, in Barni, freight forwarders/carriers list prices at which they are willing to sell an item, and customers may then purchase the item at the price offered. At no time in Barni is a priced object generated for a selected item for sale in a first electronic business and received by a second electronic business, wherein the second electronic business modifies the priced object as is recited in claim 1.

The Examiner refers to Fig. 2 (32); Fig. 4 (66); col. 4, lines 15-41 as disclosing the step of providing a priced object to a second electronic business. Applicants respectfully disagree. Element 32 in Fig. 2 of Barni is a link that navigates to a published rates page as is illustrated in Figure 4 of Barni. The rates page illustrated in Fig. 4 comprises a listing of rates of all suppliers. Element 32 is not a priced object received by a second electronic business, wherein the second electronic business modifies the priced object as is now recited in claim 1. Similarly, element 66 in Fig. 4 of Barni is the price of a published discount. This price is provided by a seller to a buyer but is not a priced object generated for a selected item for sale in a first electronic business and received by a second electronic business, wherein the second electronic business modifies the priced object.

Column 4, lines 15-41 of Barni reads as follows:

Fig. 2 is a simplified user interface illustrating a home page for the web site of the present invention. A user, which may be a customer or a carrier/forwarder as will be seen, navigates to this page in the normal manner, i.e., by entering the URL for the page in the user's web browser or by activating a bookmark or link. The home page preferably includes a set of links. A first link 30 navigates to a registration page illustrated in Fig. 3. A second link 32 navigates to a published rates page as illustrated in Fig. 4. A third link 34 navigates to an auction block and, in particular, to a page at which customer bids are posted. Such bids are sometimes referred to herein as buyer bids because they are bids by which customers buy the right to ship goods on particular shipping lanes of interest at auctioned rates. A fourth link 36 navigates to the auction block and, in particular, to a page at which forwarder/carrier bids are posted. Such bids are sometimes referred to herein as seller bids because they are bids by which freight forwarders and carriers sell the right to ship goods on particular shipping lanes of interest at auctioned rates. As will be seen, the participants may use the auction block anonymously. As illustrated in Fig. 2, preferably a password is required before a given participant (buyer or seller) may access the auction block. To this end, a user may enter the password in the field 38 or, alternatively, select a password button that calls a CGI script (or the like) that must be completed before the participant obtains access to the auction block. This is not a requirement of the present invention, however.

The above section of Barni describes that a freight forwarder/carrier may post a bid at which it is willing to ship goods, or a customer may post a bid at which it is willing to pay to have goods shipped. The section nowhere discloses that a priced object is generated for a selected item for sale in a first electronic business and that the generated priced object is received by a second electronic business, wherein the second electronic business modifies the priced object.

In the Office Action, the Examiner states with respect to original dependent claim 2, subject matter of which has been incorporated into amended claim 1:

- Second electronic system modifies priced object: an open bidding forum permits one or more online sellers of cargo space to view a competitor's bid, adjust terms of sale, and post their modified bids for consumer comparison shopping (see at least Fig. 6 (90-96); Fig. 7 (98-110); Fig. 8 (116-130); col. 6, lines 19-65).

Neither of Figs. 6, 7 or 8 of Barni discloses a bidding forum in which competitors modify bids after viewing other competitors' bids. Col. 6, lines 19-65 of Barni, refers to

Figs. 6-8 and describes a procedure wherein a customer can post a bid that may be accepted by given carriers, or carriers may post bids that may be accepted by given customers. There is absolutely no disclosure of one competitor modifying its bid after receiving a priced object describing terms of an offer of sale of a selected item by another competitor.

For at least all the above reasons, Barni does not anticipate claim 1, and claim 1 is believed to be allowable thereover in its present form.

Claims 3-12 depend from and further restrict claim 1, and are also not anticipated by Barni, at least by virtue of their dependency.

Independent claims 17 and 31, as amended herein, recite limitations similar to claim 1 and are not anticipated by Barni for substantially the same reasons discussed above with respect to claim 1. Claims 17, together with claims 19-29 dependent thereon, and claim 31, together with claims 33-41 dependent thereon, should, accordingly, also be allowable in their present form.

Independent claims 13, 29 and 42 should also be allowable in their present form for at least the reasons discussed above with respect to claim 1.

Independent claim 15 reads as follows:

15. A method of performing offer term comparison between a first electronic business and a second electronic business, comprising:

- generating a priced object for an item for sale by the first electronic business, the priced object including first terms of sale of the item by the first electronic business;

- receiving the priced object by the second electronic business;

- comparing the first terms of sale of the item with second terms of sale of the item associated with the second electronic business; and

- modifying the second terms of sale of the item based on the comparison of the first terms of sale with the second terms of sale.

In addition to failing to disclose steps of providing a generated priced object for an item of sale that includes first terms of sale of the item by a first electronic business, and receiving the priced object by a second electronic business, as discussed above, Barni also does not disclose comparing the first terms of sale of the item with second terms of sale of the item associated with the second electronic business, and then modifying the

second terms of sale of the item based on the comparison of the first terms of sale with the second terms of sale, as is now recited in claim 15.

Claim 15, accordingly, should also be allowable in its present form.

Therefore, the rejection of claims 1, 3-13, 15, 17, 19-29, 31 and 33-42 under 35 U.S.C. § 102 has been overcome.

Furthermore, claims 1, 3-13, 15, 17, 19-29, 31 and 33-42 would not be obvious in view of Barni. Barni is not related to a method that includes generating a priced object for a selected item for sale in a first electronic business, and receiving the priced object by a second electronic business, wherein the second electronic business modifies the priced object. Only the present application contains such a disclosure. One of ordinary skill in the art having the teachings of Barni before him, accordingly, would, not be led to modify Barni to achieve the present invention.

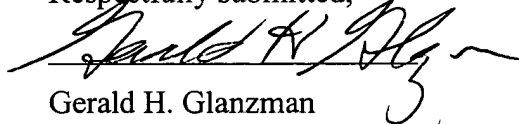
### **III. Conclusion**

For all the above reasons, claims 1, 3-13, 15, 17, 19-29, 31 and 33-42 are believed to patentably distinguish over the cited art, and this application is believed to be in condition for allowance. It is, accordingly, respectfully requested that the Examiner so find and issue a Notice of Allowance in due course.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: May 26, 2004

Respectfully submitted,



Gerald H. Glanzman

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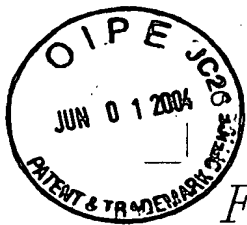
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Hommel et al.

Apparatus, Method and Computer Program Product  
for Creating and Using a Priced Object

FIG. 3

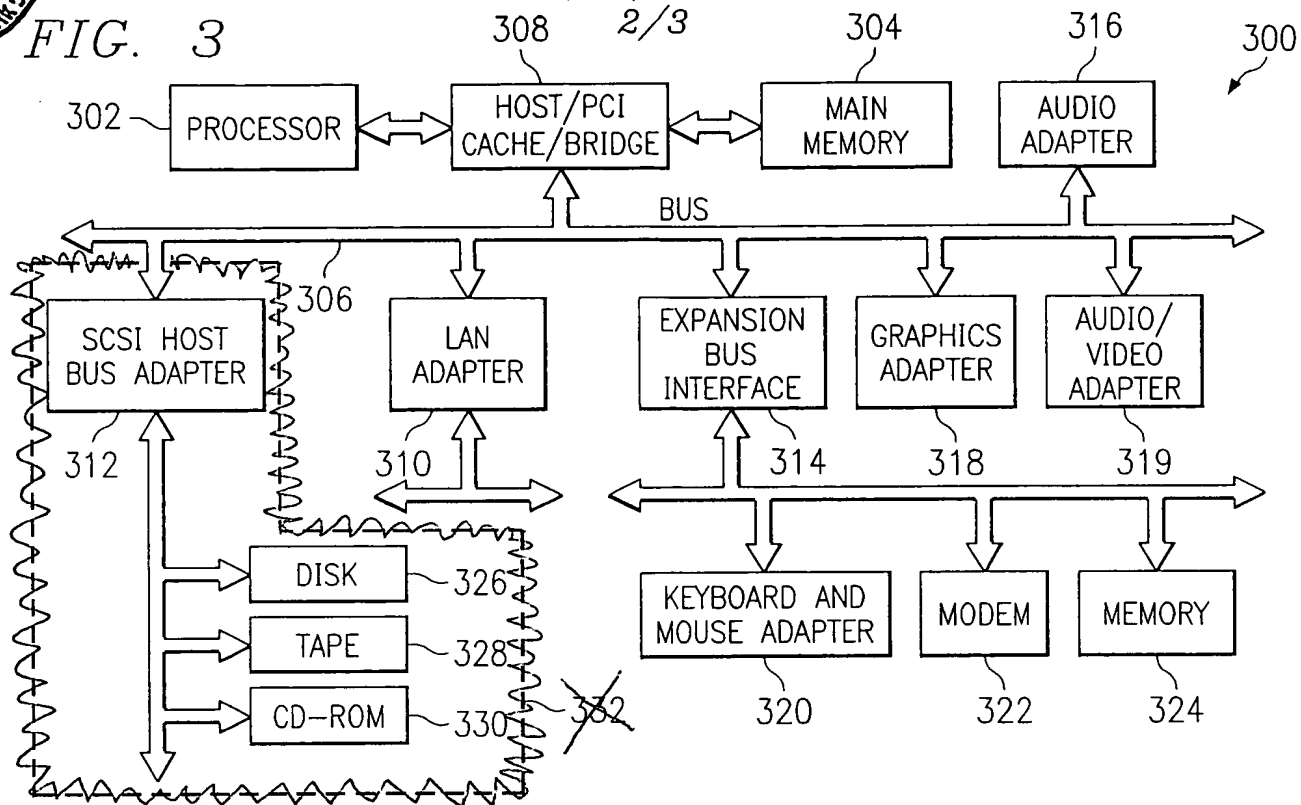


FIG. 4

